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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,585	03/18/2004	Kathleen Nylund Jackson	247079-000299USPT	7261
76243	7590	03/17/2010		
NIXON PEABODY LLP			EXAMINER	
300 S. Riverside Plaza			HU, KANG	
16th Floor				
CHICAGO, IL 60606			ART UNIT	PAPER NUMBER
			3715	
			MAIL DATE	DELIVERY MODE
			03/17/2010 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/804,585

**Applicant(s)**

JACKSON, KATHLEEN NYLUND

**Examiner**

KANG HU

**Art Unit**

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10, 15-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 15-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Present office action is in response to amendment filed 11/3/2009, claims 9, 11-14 and 22 are cancelled, claims 1-8, 10, 15-21 and 23-28 are currently pending in the application.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8, 16-21, 23-26, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Olsen (US 6,146,273).

Re claims 1 and 21, Olsen teaches a method of playing a gaming system played by a plurality of players where a jackpot is awarded, the method comprising:

players playing an underlying wagering game in which wagers are made by players (col 5, lines 1-2 and 16-22);

when an outcome occurs in the underlying wagering game that identifies that a jackpot is to be awarded to at least one of said players (col 7, lines 50-53), entering a special bonus event for all of said players presently playing the underlying wagering game (fig 4: 248 – start bonus mode; col 12, lines 20-25); the special bonus event providing a chance to be awarded bonus (col 8, lines 23-34);

randomly selecting bonuses to be awarded in the special bonus event (col 16, line 64 - col 17, line 27);

and randomly selecting more than one but less than all of said players to be awarded the randomly selected bonuses and excluding at least one player from being awarded any bonus (col 14, lines 8-10: random selector to provide the random selection of eligible gaming machines (and therefore eligible players ) to award bonus jackpots; col 15, lines 45-60: first and second bonus jackpot; col 16, lines 24-30: never selected to receive a bonus), said randomly selected bonuses being in addition to any awards some of said players may win during continued play of the underlying wagering game (col 17, lines 46-61).

Re claims 2 and 23, the underlying game is a casino table game (col 5, lines 1-5).

Re claims 3 and 24, the underlying game is played on a slot-type wagering apparatus (col 5, lines 1-5).

Re claims 4 and 25, the slot-type wagering apparatus is a networked wagering apparatus (col 5, lines 1-5).

Re claim 5, the jackpot is a progressive jackpot (col 5, line 39-40).

Re claims 6-8 and 26, the bonuses do not decrement the jackpot (col 24, lines 40-45).

Re claims 16-20 and 28, the bonus is selected from a group consisting of random bonus awards (col 17, table 1).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US 6,146,273) in view of Luciano Jr. et al. (US 6,887,154 B1).

Re claims 10, 15, and 27, Olsen does not teach of excluding the player who received the jackpot from being randomly awarded a bonus from the special bonus events. Luciano teaches of excluding the player who received the jackpot from being randomly awarded a bonus from a special bonus event (Luciano, col 4, lines 40-50);

At the time of the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to exclude the player who received the jackpot from being randomly awarded a bonus from the special bonus event because applicant has not disclosed that excluding the player who received the jackpot from the special bonus provides an advantage, is being used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Olsen and applicant's invention, to perform equally well to include or exclude the person who has won the jackpot from being randomly awarded a bonus

from a special bonus event because both would still allow the casino to randomly award bonuses to players who are currently playing to keep the player's interest in the game.

Therefore, it would have been prima facie obvious to modify Olsen to exclude the player who has won the jackpot from being randomly awarded a bonus from a special bonus event because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Olsen.

#### ***Response to Arguments***

5. Applicant's amendment filed on 11/3/2009, with respect to claims 1-8, 10, 15-21 and 23-28 in regards to USC 101 rejection have been fully considered and are persuasive. The rejection has been withdrawn.

6. Applicant's arguments filed 11/3/2009 in regards to the prior art rejection have been fully considered but they are not persuasive. The applicant asserts that at least claims 1 and 21 are not anticipated, the examiner respectfully disagree. The applicant asserts that Olsen does not teach of awarding bonus triggered by a jackpot awarded as specifically claimed. The examiner agrees with the applicant's analysis of the prior art, however the claim limitation as provided recites "identifies that a jackpot is to be awarded", nothing in the claim requires that an awarded jackpot triggers a bonus event. Olsen teaches of at least triggering of jackpot award to at least one of the player as recited in the claim. Therefore the argument is not persuasive.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KANG HU whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-262-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/  
Primary Examiner, Art Unit 3715

/K. H./  
Examiner, Art Unit 3715